

Remarks:

Applicant has carefully studied the Office Action dated August 31, 2004, and has amended the claims to distinctively recite the subject matter of the invention. By virtue of this amendment, claims 1, 11 and 17 are amended. No new matter has been added. Support for the new claims and the amendments is found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 102 Rejections:

Amended claims 1, 11, and 17 recite a fishing lure comprising a lure body having a resilient portion for fully encapsulating at least two separate rigid components connected to two separate sections of an elongate memory alloy for allowing the lure body to flex, wherein the memory alloy is configured to maintain its original shape although flexible enough to bend in various directions. The applicant has reviewed the cited references (JP Patent No. 10-262501, Righetti, Hawley, etc.). Neither of the references teach, suggest, or disclose a combination of or a motivation to combine the above claimed elements in the manner recited.

JP Patent No. 10-262501 is directed to a fishing jig composed of a sinker 35 made of lead and welded to a wire part made of shape memory alloy. A resilient body 32 covers only the wire part. In contrast, the claimed invention comprises two separate rigid components connected to separate sections of an elongated wire made of memory alloy, wherein the two separate rigid components are almost entirely encapsulated by a resilient portion.

Referring to claims 1, 11 and 17 and Figures 3 and 4 of JP Patent No. 10-262501, the cited Japanese reference does not teach or suggest all the recited elements (first rigid component, second rigid component, a memory alloy, a resilient portion) and the particular relationships between the elements (first and second rigid components being connected to two separate sections of the elongated memory alloy and almost entirely

encapsulated in the resilient portion). The cited Japanese reference cannot be modified in the direction of the claimed invention because it teaches a jig designed to have a single sinker portion for sinking head first in water. Modifying the jig to include another sinker portion connected to another end of the memory alloy will destroy the jig's intended function. As such, the claimed invention is patentably distinguishable over JP Patent No. 10-262501.

It should be noted that anticipation of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." M.P.E.P. § 2125. Furthermore, anticipation of a claim under 35 U.S.C. § 102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131. Since the cited references, as noted above, each fail to disclose at least one of the recited elements in the amended claims, they are improper §102 references.

§ 103 Rejections:

The Examiner contends that Righetti and Hawley references can be combined with JP Patent No. 10-262501 to teach the claimed invention. The Applicant respectfully traverses this grounds of rejection for the reasons provided below.

The Righetti reference is directed to a fishing lure with plurality of segments joint together by an internal membrane 900 that runs the length of each segment (see col. 6, lns. 40-50). "Gap spacing is provided between the plurality of segments to permit respective adjacent segments to move side to side in a generally serpentine manner as the lure moves through the water" (see col. 8, lns. 30-35). Righetti fails to disclose a "resilient cover" for housing the segments or a "memory alloy" for connecting the segments, as claimed.

It is repeatedly suggested in the Righetti reference that the serpentine motion through the water is achieved only by combining the particular effects of the lure with gap spacing between segments and the weight placement (see col. 2, lns. 24-37). As such, Righetti cannot be combined with JP Patent No. 10-262501. That is, if the teachings of Righetti are applied to JP Patent No. 10-262501, the cover will resultantly contain the spaced apart segments.

Therefore, the serpentine motion of the lure will be limited as the cover would prevent the segments from freely moving around. Since this goes against the essential nature of the lure disclosed in Righetti, a person skilled in the relevant art would not have found it reasonable to combine Righetti and JP Patent No. 10-262501. For this reason, the combination of Righetti with JP Patent No. 10-262501 would seem improper to one of ordinary skill in the art.

Furthermore, the teachings of Hawley are inapplicable to JP Patent No. 10-262501. The Examiner contends that Hawley teaches the claimed memory alloy of the present invention. Particularly, the Examiner refers to columns 1 and 2 of Hawley suggesting that the element identified by numeral reference 15 is a shape memory alloy.

Shape memory alloys are well known in the art as metals that are configured to revert back to their original shape after being strained or bent. The Applicant has thoroughly reviewed the Hawley reference. Neither the referenced portions nor any other portion of Hawley teach, suggest or disclose a shape memory alloy as claimed in amended claims 1, 11 and 17, wherein the memory alloy is configured to maintain a particular shape although flexible enough to bend in various directions.

Referring to columns 1 and 2 of Hawley, the reference numeral 15 is defined as a Nitinol bending actuator connected to a circuit board 20. According to Hawley, the bending actuator changes shape (i.e., moves) when it is heated by way of an electric pulse provided from circuit board 20. That is, electric pulses applied to the actuator 15 cause

the actuator to move around, simulating the movement of a body of a worm in a realistic manner to resemble live bait.

The above teaching is inconsistent with the language of claims 1, 11 and 17, as amended, that recites a shape memory alloy, which is configured to maintain its original shape despite of having the capacity to bend in various directions. More particularly, Hawley teaches a wire that is configured to “changes its shape” as a result of application of electric pulses. In contrast, the memory alloy of the present invention, as claimed, is configured to “maintain its shape” regardless of application of external forces. That is, the memory alloy has a memory to return to its original shape after it has been bent in various directions.

It is well settled that there must be some motivation or suggestion to combine, in the prior art references themselves, to come up with the claimed invention. Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings.” In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983).

It is respectfully submitted that Hawley cannot be combined with JP Patent No. 10-262501 to teach the claimed invention. There is no indication in the Office Action how such combination is possible, as the recited structures are independent from one another and cannot be easily modified to work with each other. Further, even if they can be combined, the resultant combination will not operate to perform the claimed function.

That is, combining the electrical circuit of Hawley into the lure structure of JP Patent No. 10-262501 will only result in the lure moving and changing its particular shape in response to the generated electric pulses. This is directly contrary to the claimed function of the memory alloy in the present invention, which is to maintain the original shape of the alloy, rather than actively changing it.

For the above reasons, the invention as recited in the amended claims 1, 11 and 17 is distinguishable over the references cited by the Examiner. Claims 2-10, 12-15 and 18-20, respectively depending on claims 1, 11 and 17 should also be in condition for allowance by virtue of being dependent on allowable claims.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789 2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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